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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Paper No. 17

Application Number: 09/507,945
Filing Date: February 22, 2000
Appellant(s): WILLIAMS, STEPHEN

Perman & Green, LLP.
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed July 07, 2003.

(1)   *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or

be directly affected by or have a bearing on the decision in the pending appeal is contained in the

brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in

the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

Appellant's brief includes a statement that claims 1-3, 4-6, and 11-12 do not stand or fall

together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

| 6,011,554 | King et al. | 1-2000 |
| 6,185,295 | Frederiksen et al. | 2-2001 |

(10)   Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

1.   Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over King et al.

("King", US 6,011,554) in view of Frederiksen et al. ("Frederiksen". US 6.185,295).

As per claims 1-3, King teaches a communication terminal having:

a display (col.6, line 21);

a keypad for use in the operation of said communication terminal having a

plurality of keys associated with several letters each (col.2, lines 63-65);

processor means controlling the display in accordance with the operation of the

keypad (col.6, lines 50-52);

a predictive editor program for generating an output containing word matching a

received string of ambiguous key strokes (col.3, lines 6-8), said predictive editor program

having a number of associated vocabularies including at least one language dependent

dictionary and at least one dictionary receiving user defined inputs stored in a first

memory which serves said predictive editor program (col.6, lines 58-60; col.22, lines 13);

and

an editor application controlled by the processor means communicates with said

predictive editor programs for generating matching words based on an ambiguous string

of key strokes (col.3, lines 6-8).

Furthermore, King teaches the step of copying words into said at least one dictionary for

receiving user defined inputs and associated with said predictive editor program from a variety of

other sources that can be searched and downloaded to the dictionary (col.22, lines 9-11).

However, King does not explicitly disclose the source to be a second memory means of the

communication terminal serving an independent application program for storing user inputted

data in an electronic database wherein the memory is an electronic phonebook database stored on

a Subscriber Identity Module (SIM) in a cellular phone. Frederiksen teaches a communication

terminal comprising a phonebook database stored on an exchangeable SIM card that can be

copied to the memory of the phone (col.3, lines 47-49; fig.4). It would have been obvious to an

artisan at the time of the invention to combine Frederiksen's teaching with King's system in order

to expand the dictionary to provide additional matching words.

2.   Claims 4 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over King et

al. ("King", US 6,011,554).

As per claims 4, King teaches a communication terminal having:

a display (col.6, line 21);

a keypad having a plurality of keys associated with several letters each (col.2, lines 63-

65), processor means controlling the display in accordance with the operation of the keypad

(col.6, lines 50-52);

a predictive editor program for generating an output containing words matching a

received string of ambiguous key strokes (col.3, lines 6-8), said predictive editor program having

a number of associated vocabularies including at least one language dependent dictionary and at

least one dictionary receiving user defined inputs (col.6, lines 58-60; col.22, lines 1-3);

an editor application controlled by the processor means communicates with said

predictive editor programs for generating matching words based on an ambiguous string of key

strokes (col.3, lines 6-8); and

King teaches an editor application for entering words in an unambiguous form. However, King

does not explicitly disclose the editor application to be used to revise, delete, and/or combine

words. Official Notice is given that such managing operations for user-defined lists were well

known in the art at the time of the invention. It would have been obvious to an artisan at the time

of the invention to include such managing operations in King's system in order to maintain the

user-defined lists of words.

Claim 12 is similar in scope to claim 4, and is therefore rejected under similar rationale.

3.   Claims 5-6 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over King et

al. ("King", US 6,011,554) in view of Schroeder et al. ("Schroeder", US 5,797,098).

As per claims 5-6 and 11, King teaches a communication terminal wherein said editor

application stores words that have to be entered in an unambiguous way in one of said at least

one dictionary receiving user defined inputs (col.22, lines 1-7) and teaches the association of a

frequency of use to each word (col. 13, lines 65-67). However, King fails to teach associated a

storing time for the unambiguously entered words stored in the dictionary receiving user defined

inputs, updating the storing time every time the word is used, and maintaining the dictionary as a

cyclic buffer wherein the word having the oldest storing time is removed from the memory when

a new word is added and the buffer is full. Schroeder teaches a communication terminal with a

predictive input method wherein a time is associated to each new word, updated each time the

word is used (col.7, lines 45-47), and wherein old words are replaced by new words once the

buffer is full (col.7, lines 47-50). It would have been obvious to an artisan at the time of the

invention to include Schroeder's teaching with King's system in order to make efficient use of the

system by freeing up memory for words which are entered most frequently.

(11)   Response to Argument

Applicant argues the following:

a.   The memory on the SIM card of Frederiksen et al. cannot be copied to the

memory of the phone.

b.   There is no indication as to what incentive is present in the references to

encourage a person skilled in the art to make the combination of King et al. and

Frederiksen et al.

c.   King does not disclose "the editor application to be used to revise, delete and/or

combining words" (sic), and this statement remains unsupported by any reference.

The Examiner disagrees for the following reasons:

Per (a), Frederiksen clearly teaches that information can be copied from the SIM card to

internal memory 12 (col. 3 lines 58-61 and elements 11-12 of fig. 4), and two phone numbers can

be swapped (copied) between the two memory locations (col. 5 lines 14-17). In this case,

swapping means copying data from the SIM card location (element 11 of fig. 4) to RAM

memory location (element 12 of fig. 4) to be able to use and process that data of the SIM card.

Per (b), in response to applicant's argument that there is no suggestion to combine the

references, the examiner recognizes that obviousness can only be established by combining or

modifying the teachings of the prior art to produce the claimed invention where there is some

teaching, suggestion, or motivation to do so found either in the references themselves or in the

knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071,

5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir.

1992). In this case, it is well known in the art that SIM card and other removable memory

devices are used to expand the storage capability for additional matching words in order to

provide more flexibility and convenience for the users.

Per (c), King clearly shows the Editing words capability (col. 19 line 65-col. 39, col. 22

lines 27-44, figs. 8A-D, and 11-12).

For the above reasons, it is believed that the rejections should be sustained.

STEVEN SAX
PRIMARY EXAMINER

Respectfully submitted,

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October 27, 2003

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